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To: **Mail Stop Appeal Brief- Patents**  
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From: George M. Macdonald  
Date: April 12, 2004  
Subject: Serial No.: 10/065,286  
Pages: 12 (including this cover)

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Re: U.S. Patent Application Serial No.: 10/065,286  
Our Docket # F-380

Enclosed please find Appellant's Brief on Appeal in furtherance of the February 11, 2004 Notice of Appeal.

**CERTIFICATION OF FACSIMILE TRANSMISSION**

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1. Appellant's Brief on Appeal (11 pages).

on April 12, 2004  
Date of Transmission

  
Signature

George M. Macdonald  
Name of Registered Rep.  
Reg. No.: 39,284

April 12, 2004  
Date

(GMM0148.1)

Serial No.: 10/065,286  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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In re patent application of: ) Attorney Docket No.: F-380  
Christian A. Beck ) Customer No.: 00919  
Serial No.: 10/065,286 )  
Filed: September 30, 2002 ) Examiner: Rogers, David A.  
Confirmation # 5702 ) Group Art Unit: 2856  
Date: April 12, 2004

Title: HAZARDOUS MATERIAL DETECTOR FOR DETECTING  
HAZARDOUS MATERIAL IN A MAILSTREAM

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
Alexandria, VA 22313-1450

**APPELLANT'S BRIEF ON APPEAL**

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-7 of the above-identified application mailed November 12, 2003. Claims 1-7 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on February 11, 2004. This Brief is transmitted in triplicate. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on April 12, 2004 (Date of Transmission).  
George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

 (Signature) April 12, 2004 (Date)

(GMM0145.1)

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Attorney Docket No.: F-380

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**I. Real Party in Interest**

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

**II. Related Appeals and Interferences**

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**III. Status of Claims**

Claims 1-7 are in the case and under final rejection of the Examiner.

Claims 1 and 6 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2003/0085266 to Simon (Simon '266") in view of U.S. Patent No. 6,295,506 to Heinonen, et al. (Heinonen '506") and U.S. Patent Application Publication 2002/0072733 to Flaherty ("Flaherty '733").

Claims 2, 4 and 5 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2003/0085266 to Simon (Simon '266") in view of U.S. Patent No. 6,295,506 to Heinonen, et al. (Heinonen '506") and U.S. Patent Application Publication 2002/0072733 to Flaherty ("Flaherty '733") and further in view of U.S. Patent No. 4,840,919 to Attar ("Attar '919") and U.S. Patent No. 6,254,846 to Robinson, Jr. ("Robinson '846").

Claim 3 stands rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2003/0085266 to Simon (Simon '266") in view of U.S. Patent No. 6,295,506 to Heinonen, et al. (Heinonen '506") and U.S. Patent Application Publication 2002/0072733 to Flaherty ("Flaherty '733") and further in view of U.S. Patent No. 4,840,919 to Attar ("Attar '919") and U.S. Patent No. 6,254,846 to Robinson, Jr. ("Robinson '846").

Claim 7 stands rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2003/0085266 to Simon (Simon

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'266") in view of U.S. Patent No. 6,295,506 to Heinonen, et al. (Heinonen '506") and U.S. Patent Application Publication 2002/0072733 to Flaherty ("Flaherty '733") and further in view of U.S. Patent No. 6,254,846 to Robinson, Jr. ("Robinson '846").

Appellant hereby appeals the rejection of claims 1-7.

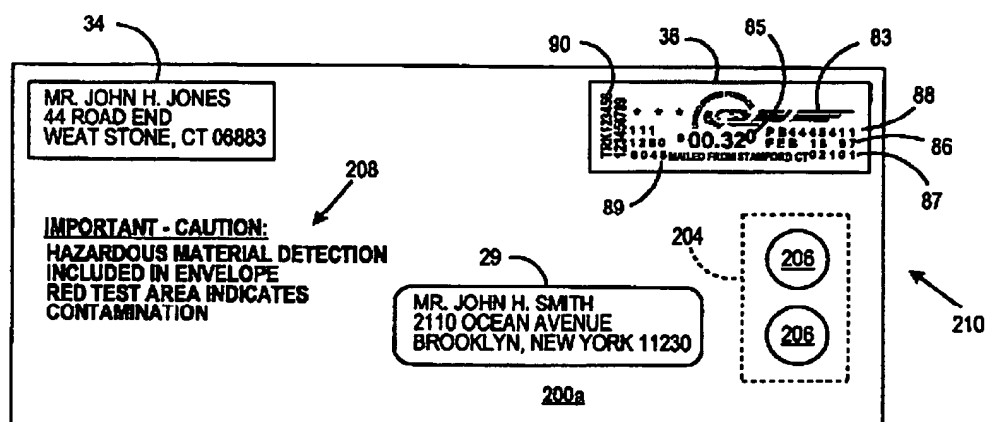
#### IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of November 12, 2003. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

#### V. Summary of Invention

Appellants' invention relates to hazardous material detectors for detecting hazards in a mail stream. Figure 6 is reproduced below for use in a summary discussion of an illustrative embodiment. As can be appreciated from Figure 6, a hazardous material detection mailpiece 210 has a recipient address field 29 printed on the envelope front side 200a and a sender address field 8. A postal indicia 36 is affixed

**FIG. 6**



to mailpiece 30. Indicia 36 contains a dollar amount 85; the date 86 that postal indicia 36 was affixed to mailpiece 30; the place 87 that mailpiece 30 was mailed; the postal meter serial number 88; an eagle 83; a security code 89; and, a tracking number 7.

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Security code 89 and tracking number 90 are unique numbers that are derived from address field 29 and information contained in the postage meter that affixed indicia 36. The hazardous material detection mailpiece 210 includes a hazardous material test strip 204 which can be viewed through one or more holes 206 in the mailpiece. The holes 206 can be positioned adjacent to indicia 36 or any other suitable position including the back side of the mailpiece. The number of holes can be determined by one of ordinary skill in the art considering factors including the size of the test strip 204.

In an embodiment having a test strip insert, a printer is positioned to print on the insert, and in this example, to print a barcode or Identification (ID) number on the insert. The ID number would serve to preserve a record the time, date or other information pertaining to the insert so that the Identification information could later be used in processing. For example, if the envelope 200 containing the insert 204 was destroyed, the ID number could be used to determine when the insert was prepared etc.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

#### VI. Issues

Whether claims 1-7 are patentable under 35 U.S.C. §103(a).

#### VII. Grouping of Claims

Claims 1-7 are grouped in the following groups:

Group I – Claims 1 and 6-7.

Group II - Claim 2, and 4-5.

Group III – Claim 3.

In Group I, independent claim 1 and claims 6 and 7 that each depend directly from claim 1 stand or fall together.

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In Group II, dependent claims 2 and 4-5 that depend directly or indirectly from claim 1 stand or fall together.

In Group III, claim 3 that depends indirectly from claim 1 stands or falls alone.

#### VIII. Argument

As Appellant discusses in detail below, the final rejection of several of claims 1-7 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a *prima facie* case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

##### A. The Simon '266 and Flaherty '733 References are Not Properly Combined Under 35 U.S.C. Section 103(a)

Initially, the Examiner relies on the filing date of a related provisional patent application in the Simon '266 reference, yet does not provide a copy of the earlier reference to support entitlement to the earlier filing date for the material cited. Accordingly, Appellant respectfully submits that the reference is not available as prior art.

Appellant argues that there is no motivation to combine the references. For the rejection to stand, there must be some teaching, suggestion or motivation to combine the references found in the references themselves or the general knowledge of one of skill in the art. Citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the Examiner used the invention itself as the roadmap to justify combining non-analogous references by stating that

Simon does not teach the use of a barcode on the test strip that includes an identifier with time data. Heinonen et al. discloses a test strip (reference item 5) for use in analyzing biological properties of a sample. The test strip of Heinonen et al. is taught has having a barcode (reference item 7) that is used to identify the manufacturing batch number. Knowing information regarding the test strip would be desirable in case random sampling of the test strips, e.g. for quality control purposes, shows that

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certain strips are not providing the correct results, and, therefore, the remaining strips from similar batch lots have to be returned. Simon in view of Heinonen et al. does not teach the use of a barcode where the time information is stored by the barcode. Flaherty teaches that it is known in barcodes to include various information including type, volume, and concentration of a drug; expiration data of the device or drug; manufacture data of the device or drug; and other information such as serial numbers, lot numbers, hospital name, clinician name, and patient name. Clearly, Heinonen et al. in view of Flaherty teaches that barcodes can be used to store a wide variety of information pertinent to the device with the barcode. Date and time information, such as the date and time of manufacture, would be beneficial as certain test strips contain reagents whose "shelf life" is limited so that, if used after the expiration date, the test strip may not function correctly. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Simon with the teachings of Heinonen et al. and Flaherty in order to obtain a test strip with a barcode that stores information such as dates and times. (November 12, 2003 Final Office Action, pp. 2-3.)

Appellant respectfully submits that there is no motivation to combine the cited references as suggested by the Examiner. For example, the Flaherty '733 reference does not appreciate the problem of a test strip, but describes a reservoir used in a drug delivery device. As the Federal Circuit has held, "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art ..." See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998).

Furthermore, the Flaherty '733 reference describes devices, systems and methods for patient infusion with a drug delivery system. Clearly, Flaherty '733 is not even remotely related to test strip devices and is not at all pertinent to the claimed invention. Accordingly, the references are not properly combined. The rejections should be reversed because the references are not in an art analogous to that of the invention as presently claimed. See *Wang Lab., Inc. v. Toshiba Corp.*, 993 F. 2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Accordingly, the references are not properly combined and the rejection should be reversed.

**B. Claims 1 and 6-7 are not Unpatentable under 35 U.S.C. § 103(a)**

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Claims 1 and 6 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by Simon '266 in view of Heinonen '506 and Flaherty '733. Claim 7 is in the case and under final rejection of the Examiner and stands rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by Simon '266 in view of Heinonen '506 and Flaherty '733 in further view of Robinson '846.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Claim 1 is directed to a hazardous material detector including a test strip and is shown below:

1. A hazardous material detector comprising:
  - an envelope comprising a front side and a back side;
  - holes formed in at least one of the front side or the back side of the envelope;
  - a hazardous material test strip for detecting the presence of hazardous material in contact with the test strip;
  - wherein the test strip includes an identifier associated with time data; and

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whereby when hazardous materials are detected by the hazardous material test strip a physical change occurs to the hazardous material test strip and the physical change can be viewed through at least one hole formed in the at least one of the front side or the back side of the envelope. (emphasis added).

In the November 12, 2003 Final Office Action, the Examiner rejected claims 1 and 6-7 under 35 U.S.C. section 103(a). Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

The Examiner cites to Simon '266 but admits that Simon '266 does not teach the test strip including an identifier associated with time data. As described above in subsection A, the Examiner cites to Heinonen '506 to show a medical test strip that includes a bar code, but such bar code is not associated with time data. Heinonen '506 does not have anything to do with hazard detection, but rather is related to medical testing and is only tangentially related. As described above, the Examiner then cites Flaherty '733 that is related to medical drug delivery and has nothing to do with hazard detection or test strips. The references are not properly combined. Furthermore, even if the references were to be found to be properly combined, the references do not teach or fairly suggest the invention as presently claimed and in particular do not teach or suggest a test strip having an identifier associated with time data.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Dependent claims 6-7 includes similar elements and are patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 1 and 6-7 is in error and should be reversed.

C. Claims 2 and 4-5 are Not Unpatentable Under 35 U.S.C. section 103(a)

Claims 2, 4 and 5 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by Simon

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'266 in view of Heinonen '506 and Flaherty '733 and further in view of Attar '919 and Robinson '846.

Claim 4 is directed to a hazardous material detector and is shown below:

4. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is mounted on a holder and contained in a carrier. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. As described above, the references are not properly combined. The claims are patentable for at least the reasons stated above with reference to independent claim 1.

The Examiner cites to Attar '919, but does not show a holder in a carrier in which the test strip may move. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Claims 2 and 5 that depend directly or indirectly from claim 1 include similar elements and are patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 2 and 4-5 is in error and should be reversed.

D. Claims 3 is Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 3 is in the case and under final rejection of the Examiner and stands rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by Simon '266 in view of Heinonen '506 and Flaherty '733 and further in view of Attar '919 and Robinson '846.

Claim 3 depends indirectly from claim 1 and is patentable for at least the reasons as described above with reference to claim 1. Additionally, they are patentable over the cited reference for the following reasons. Claim 3 recites:

3. The hazardous material detector as claimed in claim 2 wherein the holder and hazardous material test strip mounted thereon are smaller than the envelope and whereby the holder move while positioned inside the envelope. (emphasis added).

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The Examiner cites to Attar '919, but does not show a holder in a carrier in which the test strip may move. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

For at least these reasons, Appellant respectfully submits that the final rejection as to claim 3 is in error and should be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejection of claims 1-7 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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### **APPENDIX A**

1. A hazardous material detector comprising:
  - an envelope comprising a front side and a back side;
  - holes formed in at least one of the front side or the back side of the envelope;
  - a hazardous material test strip for detecting the presence of hazardous material in contact with the test strip;
  - wherein the test strip includes an identifier associated with time data; and
  - whereby when hazardous materials are detected by the hazardous material test strip a physical change occurs to the hazardous material test strip and the physical change can be viewed through at least one hole formed in the at least one of the front side or the back side of the envelope.
2. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is mounted on a holder.
3. The hazardous material detector as claimed in claim 2 wherein the holder and hazardous material test strip mounted thereon are smaller than the envelope and whereby the holder move while positioned inside the envelope.
4. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is mounted on a holder and contained in a carrier.
5. The hazardous material detector as claimed in claim 4 wherein holes are formed in the carrier.
6. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is positioned adjacent to the front side of the envelope.
7. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is positioned adjacent to the back side of the envelope.

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